

REMARKS

Applicant thanks the Examiner for the careful consideration given to this application. Reconsideration is now respectfully requested in view of the amendment above and the following remarks.

Claims 1-38 are pending in this application. Claims 1, 19 and 38 are independent claims. No claims have been amended, cancelled or withdrawn herein. Reconsideration and allowance of the present application are respectfully requested.

Interview

Applicant thanks Examiner Abrishamkar for the courtesy of the telephonic interview held on July 9, 2010. The interview was attended by Examiner Abrishamkar and Jonathan Darcy. The outstanding rejections, claims and cited art were discussed.

Entry of Amendment After Final Rejection

Entry of the Amendment is requested under 37 C.F.R. § 1.116 because the Amendment: a) places the application in condition for allowance for the reasons discussed herein; b) does not present any additional claims without canceling the corresponding number of final rejected claims; and/or c) places the application in better form for an appeal, if an appeal is necessary. Entry of the Amendment is thus respectfully requested.

Claim Rejections Under 35 U.S.C. §103

Claims 1-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,587,945 to Pasieka (hereinafter “Pasieka”) in view of U.S. Patent No. 7,295,677 to Simpson et al. (hereinafter “Simpson et al.”). These rejections are respectfully traversed for at least the following reasons.

Obviousness is a question of law that is evaluated based on underlying factual questions about the level of skill in the art at the time the invention was made, the scope and content of the prior art, and the differences between the prior art and the asserted claim. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 at 1734, 1745 (2007), (quoting *Graham v. John Deere Co.* of

Kansas City, 383 U.S. 1, 17-18 (1966). The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Applicant may traverse the Examiner's *prima facie* determination as improperly made out. *In re Heldt*, 58 C.C.P.A. 701, 433 F.2d 808, 811, 167 USPQ 676, 678 (CCPA 1970). Applicant submits a *prima facie* case of obviousness is lacking, at least by virtue that the cited references fail, in any combination, to teach or suggest each of the elements of any of the pending claims.

Claim 1 recites, *inter alia*, a memory configured to store both: (1) "electronic image data corresponding to an original tangible document, the tangible document having an electronic displayable verifiable provenance", and (2) "separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance." The Office action alleges Pasieka's server storing an image and an image signature equates to the Claim 1 recited memory configured to store both: (1) "electronic image data corresponding to an original tangible document, the tangible document having an electronic displayable verifiable provenance", and (2) "separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance." *See, 6/8/2010 Office action, pg. 4; see also, pgs. 2-3, "Response to Arguments".* Applicant traverses these assertions for at least the following reasons.

Claim 1 does not merely recite any type of document or any type of data. Rather, Claim 1 clearly and unambiguous recites each of: (1) "an original tangible document", (2) "electronic image data corresponding to [the] original tangible document" and (3) separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance [of the original tangible document]." Further, Claim 1 explicitly recites "the [original] tangible document [has the recited] electronic displayable verifiable provenance." As discussed in Applicant's prior response, a non-limiting example may take the form of a "paper document" that includes indicia 10 and that is scanned to produce image data, such as is shown in Fig. 2 of the subject application.

Contrary to the Office action allegations, an encrypted image fingerprint that serves as an image signature providing proof of authorship cannot teach "separately derived electronic displayable verification information corresponding to the electronic displayable provenance."

Pasieka's image signature corresponds to the Pasieka image itself, rather than the “*electronic displayable verifiable provenance*” of the “*the [original] tangible document*” – as is recited by Claim 1. *See, e.g., Pasieka, Col. 1, ll. 18-21 (“A one-way hash of the document is produced, and the hash is encrypted using a private key of the owner of the document in order to form a so called digital signature.”).*

By way of further explanation, the Office action argues Pasieka teaches an image that may be produced by a scanner and “has an electronically verifiable provenance as the transmission includes an author identifier and an imager device identification.” *See, 6/8/2010 Office action, pg. 2, “Response to Arguments”, l. 7 – pg. 3, l. 2.* However, Claim 1 does not merely call for “an image” having “an electronically verifiable provenance”, but rather explicitly recites “electronic image data corresponding to an original tangible document, *the tangible document having an electronic displayable verifiable provenance.*” (Emphasis added). Further, even if Pasieka’s image results from a scan of an “original tangible document” as is alleged by the Office action, *the original scanned document does not include the image signature.* Thus, the signature fails to even correspond to the recited original tangible document at all, no less the recited “*electronic displayable verifiable provenance*” included in “*the [original] tangible document*” – as is recited by Claim 1.

Further, the Office action seems to allege that any document that may be perceived equates to the Claim 1 recited, “original tangible document.” *See, 6/8/2010 Office action, pg. 2, “Response to Arguments”, ll. 5-7.* Applicant traverses this assertion as well.

Applicant acknowledges the PTO utilizes the “broadest reasonable interpretation” standard. *See, e.g., MPEP §2111.* However, claims must be interpreted in light of the specification and in view of one skilled in the art. *See, e.g., Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005); see also, e.g., In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).* And, “[t]he protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation.” *In re Skvorecz, No. 2008-1221 (Fed. Cir. Sept. 3, 2009) at 8.* Rather, “[t]his protocol is solely an examination expedient, not a rule of claim construction.” *Id.*

As discussed in Applicant’s prior response, a non-limiting example of certain embodiments of the present invention may take the form of a “paper document” that includes

indicia 10 and that is scanned to produce image data, such as is shown in Fig. 2 of the subject application. Accordingly, it is improper to attempt to equate the Claim 1 recited, “[original] tangible document” to Pasieka’s “electronic image”, particularly since Claim 1 also recites “electronic image data corresponding to [the] original tangible document.”

Further, even assuming, *arguendo*, Pasieka’s electronic image could be considered the recited “original tangible document” recited by Claim 1, and Pasieka’s image signature could be considered the recited “provenance” of Claim 1, the asserted combined Pasieka and Simpson teachings would then nonetheless still fail to teach or even suggest the separately recited “image data” of Claim 1.

Accordingly, Applicant submits Pasieka’s electronic image and image signature fail to teach or even suggest the Claim 1 recited (1) “electronic image data corresponding to an original tangible document, the tangible document having an electronic displayable verifiable provenance”, and (2) “separately derived electronic displayable verification information corresponding to the electronic displayable verifiable provenance” – at least by virtue that Pasieka’s image signature corresponds to the electronic image itself rather than an electronic displayable verifiable provenance of the original tangible document.

Accordingly, Applicants respectfully request the rejection of Claim 1 under 35 U.S.C. §103 be withdrawn, at least by virtue that Pasieka and Simpson fail both in alone and in combination to teach or suggest each of the limitations of Claim 1. Applicants also request reconsideration and removal of the rejections of Claims 2-18 as well, at least by virtue of these claims’ ultimate dependency upon base Claim 1.

Turning to amended Claim 19, while of different scope it analogously recites:

A method of displaying a document for authentication,
comprising:
 creating electronic image data corresponding to
 an original document, *the original document having an*
 electronic displayable verifiable provenance;
 providing electronic, displayable verification
 information corresponding to the electronic displayable
 verifiable provenance; and
 displaying the image data and the verification
 information, to permit a user to authenticate the original
 document,

wherein the verification information is displayed
on the image data. (*Emphasis added*)

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Claim 19 for at least the foregoing reasons as well. Applicant also requests reconsideration and withdrawal of the rejections of Claims 20-37, at least by virtue of these claims' ultimate dependency upon base Claim 19.

Turning to amended Claim 38, while also of different scope, it analogously recites:

A computer system comprising:
a unit for processing an electrical signal for displaying
a document having an electronic displayable verifiable provenance for authentication to be received by a client
computer operated by a user who wishes to authenticate the
document, wherein the electronic signal comprises:
electronic image data corresponding to the
document having the electronic displayable verifiable
provenance; and
*electronic, displayable verification
information corresponding to the electronic displayable
verifiable provenance,*
wherein the verification information is displayed on the
image data. (*Emphasis added*)

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Claim 38 for at least the foregoing reasons as well.

Therefore, Applicants respectfully request that this rejection of claims 1-38 under 35 U.S.C. §103 be withdrawn.

Disclaimer

Applicants may not have presented all possible arguments or have refuted the characterizations of either the claims or the prior art as found in the Office Action. However, the lack of such arguments or refutations is not intended to act as a waiver of such arguments or as concurrence with such characterizations.

CONCLUSION

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 22-0185.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 27592-01057-US3 from which the undersigned is authorized to draw.

Dated: August 9, 2010

Respectfully submitted,

Electronic signature: /Jonathan M. Darcy/
Jonathan M. Darcy
Registration No.: 44,054
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(302) 658-5614 (Fax)
Attorney for Applicant